

REMARKS

Applicants respectfully request reconsideration of this application, and reconsideration of the Office Action dated January 4, 2005. Upon entry of this Amendment, claims 24, 25, 31-34 and 36-48 will be pending in this application. Claims 24, 25, 31-33, 36, 37, and 39-48 are withdrawn. The changes to the claims are supported by the specification and original claims. No new matter is incorporated by this Amendment.

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Claims 34 and 38 are objected because of informalities. In response, Applicants have amended claims 34 and 38 to no longer recited the questioned terminology. Hence, the objection has been accommodated and its withdrawal is requested.

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Claim 34 is rejected under 35 U.S.C. §112, second paragraph, as purportedly indefinite. Specifically, the Office Action asserts the phrase "nozzle to said nozzle" is indefinite.

In response, Applicants have removed the above phrase from claim 34 thereby overcoming this rejection. Hence, withdrawal if this rejection is requested.

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Claims 34 and 35 are rejected under 35 U.S.C. § 102(e) as purportedly anticipated by Iwashita et al. (U.S. Pat. No. 5,989,622). Applicants note claim 35 is canceled. The Office Action asserts Iwashita describes each feature of the claims. Applicants respectfully traverse.

Claim 34 concerns an intermittent coating method for intermittent coating. The method employs an intermittent coating apparatus. The method includes applying paint intermittently to the base material such that the intermittent means:

- (i) starts discharging said paint to said return side at least by a time that said intermittent means begins feeding said paint to said nozzle in order to start said coating,
- (ii) stops discharging said paint to said return side after a predetermined period of time while continuing said paint feeding to said nozzle, and

(iii) starts discharging said paint to said return side after stopping said paint feeding to said nozzle in order to stop coating.

Iwashita neither teaches nor fairly suggests the above method wherein an intermittent means is caused to perform the above recited method steps (i)-(iii) in applying paint to a base material. As emphasized by the first full paragraph on page 10 of Applicants' specification, Applicants' method prevents swelling at the coating start end so that Applicants' intermittent coatings appear as shown by their Figure 8, as opposed to the prior art result shown by their Figure 7. In contrast, Iwashita teaches his method as for preventing undesired feeding of coating liquid beyond the coated region to ensure that the end of the coated region is distinct. See Column 6, Lines 20-35 and 54-67. Hence, Applicants and Iwashita solve very different problems in achieving intermittent coating. For Applicants, the problem is to avoid swelling at a start end. For Iwashita, the problem is to avoid dripage of coating paint beyond the desired coating boundary on to what should be uncoated regions. With these two different objectives in mind, neither disclosure can be said to recognize the problem solved by the other. Hence, Iwashita cannot be said to teach or fairly describe each and every feature of claim 34, and thus cannot anticipate this claim.

In view of the above remarks, Applicants respectfully submit that the rejection is overcome. Hence, reconsideration and withdrawal of this rejection are requested.

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Claim 38 is rejected under 35 U.S.C. §103(a) as purportedly obvious based on Iwashita et al. Applicants also respectfully traverse this rejection.

As an initial matter, Applicants point out claim 38 has been amended to depend from claim 34 and thus include all of the features of claim 34. Hence, as stated above, because Iwashita neither teaches nor fairly suggests the above method of claim 34 wherein an intermittent means performs the above recited method steps (i)-(iii), Iwashita can not be

said to render claim 38, which now depends from claim 34, obvious. Moreover, there is nothing in the teachings of Iwashita which would have motivated one of ordinary skill in the art to have employed such method steps. Hence, this rejection is overcome and its withdrawal is requested.

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Claim 34 and 35 are rejected under 35 U.S.C. §103(a) as purportedly obvious based on Milbourn et al. (U.S. Patent 5,360,629) in view of Watanabe (U.S. Patent 5,536,313).

In addition, claim 38 is rejected under 35 U.S.C. §103(a) as purportedly obvious based on Milbourn et al. in view of Watanabe, and further in view of Kaido et al. (U.S. Patent 6,284,405).

These two rejections are addressed together as similar issues apply to both. Applicants traverse both rejections.

As explained above, the method of claim 34 (from which claim 38) employs an intermittent means that:

- (i) starts discharging said paint to said return side at least by a time that said intermittent means begins feeding said paint to said nozzle in order to start said coating,
- (ii) stops discharging said paint to said return side after a predetermined period of time while continuing said paint feeding to said nozzle, and
- (iii) starts discharging said paint to said return side after stopping said paint feeding to said nozzle in order to stop coating.

According to Applicants, none of Milbourn, Watanabe and/or Kaido comes any nearer to Applicants' claimed method than does Iwashita. Like Iwashita, none of these other cited patents teaches or fairly suggests Applicants' method wherein an intermittent means performs the above recited method steps in applying paint to a base material. According to Applicants, nothing in the teachings of any of the cited patents would have motivated one of ordinary skill in the art to have arrived at such method steps. Hence, both rejections are overcome and withdrawal of both is requested.

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Applicants respectfully submit that this Amendment and the above remarks obviate the outstanding objection and rejections in this case, thereby placing the application in condition for immediate allowance. Allowance of this application is earnestly solicited.

If any fees under 37 C.F.R. §§1.16 or 1.17 are due in connection with this filing, please charge the fees to Deposit Account No. 02-4300; Order No. 033216.0381.

If an extension of time under 37 C.F.R. §1.136 is necessary that is not accounted for in the papers filed herewith, such an extension is requested. The extension fee should be charged to Deposit Account No. 02-4300; Order No. 033216.0381.

Respectfully submitted,

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